

REMARKS

The Office Action dated January 26, 2005 has been carefully reviewed and the following remarks have been made in consequence thereof.

Claims 1-18 are pending in this application. Claims 1-18 stand rejected.

The rejection of Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Haq et al. "Haq", (U.S. Patent No. 6,275,812) in view of Joao (U.S. Patent 6,662,194) is respectfully traversed.

Haq describes a system and method for human resource skill management, training, career development, and deployment for the employees of a company. The system compares the employees' skills to skills required for a position within the company in a one to one correspondence. The method uses skill templates that enable a project manager to compare the employees skills with skills that are required by each member of the project team to assess the employee's suitability for a position. A weighting system is also used to establish the relative significance of various skills. An assessment of an employee's suitability for a project within the company is based on a quantitative evaluation and not based on subjective considerations.

Joao describes a method of providing job searching services, recruitment services and/or recruitment related services related to individuals, independent contractors, freelancers, employers and/or hiring entities. The method includes an individual entering data and/or information regarding his or her education, skills, work experience, objectives and/or any other data and/or information pertinent to a job search. At step 207, the individual will enter his or her job search, including any search criteria, into the central processing computer 10 via the individual computer 20. At step 209, the central processing computer 10 will provide the individual with the report or list of available jobs and the individual decides whether to apply for any of the jobs. At step 215, the individual data and/or information is transmitted to the employer. The employer can ask for more information, for example, a resume, references, work samples, salary requirements, salary history, transcripts, or the employer can indicate that the employer is interested in the individual. If, at step 227, it is determined that the employer is interested in pursuing the opportunity with the individual, the central processing computer 10 will, at step 230, put the employer and the individual in contact with each other by transmitting contact information to either or both of the employer

and/or the individual. Notably, Joao does not describe or suggest selecting at least one candidate to interview based on the desired quality values, but rather, in contrast to the present invention, merely provides mutual contact information for an employer and an individual, who each have indicating they want to contact the other party.

Applicants respectfully traverse the assertion in the Office Action that “[t]he skills of a person possessed indicate whether the person has the analytical ability to do the job, and the skill level of the person indicates whether the person has enough self-confidence in doing the job because a highly skilled person will have more confidence than a basic skilled person in handling the same job.” The Office Action has not supplied any reference to support this assertion. The mere assertion that the skills of a person possessed indicate whether the person has the analytical ability to do the job does not support a prima facie obvious rejection. Moreover, the mere assertion that the skill level of the person indicates whether the person has enough self-confidence in doing the job also does not support a prima facie obvious rejection. These assertions must always be supported by citation to some reference work recognized as standard in the pertinent art and the Applicants given the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. Applicants have not been provided with the citation to any reference supporting the assertions made in the rejection. The rejection, therefore, fails to provide the Applicants with a fair opportunity to respond to the rejection, and fails to provide the Applicants with the opportunity to challenge the correctness of the rejection.

Applicants respectfully traverse the assertion in the Office Action that “[h]aq teaches determining if the candidate possesses at least one of a plurality of independent characteristics...and a predetermined combination of characteristics are indicative of a degree to which the candidate possesses the desired qualities.” The Office Action refers to Figure 5 as support for the assertion within the Office Action. Figure 5 illustrates a Skills Assessment form for example Engineer 1 that includes a complete listing of all the skills required for a specialty, a Technology/Product Line that allows each skill to be categorized as per technology, application, or product line. The skills assessment form not only lists all the skills required for a specialty but also assigns weights to each skill in a specialty. The weights indicate the relevant importance of each skill in performing all the job functions associated with a specialty in that technology. Rather than determining if the candidate possesses at least one of a plurality of independent characteristics, Haq merely describes

skills that are required for a specialty and a weighting system to describe the relative importance of each skill in performing all the job functions associated with a specialty in that technology. Applicants respectfully submit that assigning skills to a job function and weighting the importance of those skills to performing the job function can not fairly be equated with determining if the candidate possesses at least one of a plurality of independent characteristics wherein a predetermined combination of characteristics is indicative of a degree to which the candidate possesses the desired qualities of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills.

Applicants respectfully traverse the assertion in the Office Action that “[h]aq teaches generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities.” Haq describes an Employee Database (78) that includes the following information for each employee, Filled and approved skills assessment forms (79), a Target Career Template (80), which is a template of skill indices that an employee sets as a target of achievement for him/herself after consulting with his/her manager, a Deployment schedule and geographical location (81), and Preference sheets indicating the employee's preferences for various assignments (82), but Haq does not describe or suggest generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities.

Applicants respectfully traverse the assertion in the Office Action that “Haq teaches comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison.” Haq describes at Column 4, line 61 through Column 5, line 5 that the Skills Index Average (SIA) is a metric that compares an employee's skill level against a hypothetical individual who can perform all job functions related to a specialty at the expert level and is a weighted average of all the skill indices for an employee and compares the overall skill level of an employee against an ideal. The SIA, therefore, is an absolute measure of the career development of an employee in a particular specialty. Haq merely describes tallying a number of skills in a job function and compares the weighted average to an ideal, but Haq does not describe or suggest comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and

assigning a value to each desired quality based on the comparison. Applicants respectfully submit that skills in a job function as described by Haq can not fairly be equated with characteristics that determine desired qualities in a candidate.

Further, and to the extent understood, no combination of Haq and Joao, considered alone or in combination,, describes or suggests the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites a method for determining candidates to interview that includes “providing pre-determined desired qualities for a candidate, the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills...determining if the candidate possesses at least one of a plurality of independent characteristics, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities...normalizing the characteristics, normalizing includes comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison...displaying results for each candidate based on the desired quality values...selecting at least one candidate to interview based on the desired quality values.”

Neither Haq nor Joao, considered alone or in combination, describes or suggests a method for determining candidates to interview as recited in Claim 1. More specifically, no combination of Haq and Joao, considered alone or in combination, describes or suggests a method for determining candidates to interview that includes providing pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Moreover, no combination of Haq and Joao, considered alone or in combination, describes or suggests determining if the candidate possesses at least one of a plurality of independent characteristics wherein a predetermined combination of the characteristics are indicative of a degree to which the candidate possesses the desired qualities. Additionally, no combination of Haq and Joao, considered alone or in combination, describes or suggests generating a database including at least one characteristic for each individual wherein the at least one characteristic is correlative to the desired qualities. Further, no combination of Haq and Joao,

considered alone or in combination, describes or suggests normalizing the characteristics wherein normalizing includes comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison. Rather, Haq describes a method of optimizing the assignment of present employees of a company to positions based upon a multi-factored analysis of a database of the employees skills set, and Joao describes a method for providing mutual contact information for an employer and an individual, who each have indicated they want to contact the other party after each reviewing the other's job description or personal information.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Haq. according to the teachings of Joao. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable

expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Although it is asserted within the Office Action that Haq teach the present invention except for disclosing selecting at least one candidate to interview based on the desired quality values, and that Joao teaches selecting at least one candidate to interview based on the desired quality values, no motivation nor suggestion to combine Joao with Haq has been shown. The Office Action asserts that Joao teaches of selecting at least one candidate to interview based on the desired quality values, but rather Joao describes the individual selects an employer and information is shared between the two until one is no longer interested in the other or mutual contact information is disclosed to each of them. Joao does not describe or suggest selecting at least one candidate to interview based on the desired quality values.

Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-18 be withdrawn.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Haq in view of Joao.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5 likewise are patentable over Haq in view of Joao.

Claim 6 recites a selection system for determining candidates to interview that includes "a database comprising at least one independent characteristic for each candidate, and pre-determined dependent desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...a processor programmed to: determine

if the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values.”

Neither Haq nor Joao, considered alone or in combination, describes or suggests a selection system for determining candidates to interview as recited in Claim 6. More specifically, no combination of Haq and Joao, considered alone or in combination, describes or suggests a selection system for determining candidates to interview that includes a database including at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities and wherein a predetermined combination of the characteristics is indicative of a degree to which the candidate possesses the desired qualities. Moreover, neither Haq nor Joao, considered alone or in combination, describes or suggests a processor programmed to normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality. Furthermore, neither Haq nor Joao, considered alone or in combination, describes or suggests a processor programmed to display results for each candidate based on the desired quality values. Rather, Haq describes a method of optimizing the assignment of present employees of a company to positions based upon a multi-factored analysis of a database of the employees skills set, and Joao describes a method for providing mutual contact information for an employer and an individual, who each have indicated they want to contact the other party after each reviewing the other’s job description or personal information.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 6 is patentable over Haq in view of Joao.

Claims 7-11 depend, directly or indirectly, from independent Claim 6. When the recitations of Claims 7-11 are considered in combination with the recitations of Claim 6,

Applicants submit that dependent Claims 7-11 likewise are patentable over Haq in view of Joao.

Claim 12 recites an apparatus for screening candidates to interview that includes a processor having a memory and programmed to “a processor comprising a memory and programmed to “generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...determine if the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values.”

Neither Haq nor Joao, considered alone or in combination, describes or suggests an apparatus for screening candidates to interview as recited in Claim 12. More specifically, no combination of Haq and Joao, considered alone or in combination, describes or suggests an apparatus for screening candidates to interview that includes a database having at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities, wherein a predetermined combination of characteristics is indicative of a degree to which the candidate possesses the desired qualities. Moreover, no combination of Haq and Joao, considered alone or in combination, describes or suggests a processor programmed to normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities. Further, neither Haq and Joao, considered alone or in combination, describes or suggests a processor programmed to display results for each candidate based on the desired quality values. Rather, Haq describes a method of optimizing the assignment of employees to positions based upon a

multi-factored analysis and database. Although Haq discusses a system that enables employees to assess what specific skills are needed to perform a job function, and Joao describes a method for generating reports for assessing comparative technical skills of employees, neither Haq nor Joao describes or suggests a database having pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, nor at least one characteristic that is correlative to the desired qualities and wherein a predetermined combination of characteristics is indicative of a degree to which the candidate possesses the desired qualities.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 12 is patentable over Haq in view of Joao.

Claims 13-18 depend, directly or indirectly, from independent Claim 12. When the recitations of Claims 13-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-18 likewise are patentable over Haq in view of Joao.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1-18 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



William J. Zychlewicz
Registration No. 51,366
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070